



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,092	10/23/2001	Robert Gropp	LNUP:111_US_	9349

7590 12/14/2004

Hodgson Russ LLP  
Intellectual Property Group  
Suite 2000  
One M & T Plaza  
Buffalo, NY 14203-2391

EXAMINER

NAGPAUL, JYOTI

ART UNIT	PAPER NUMBER
----------	--------------

1743

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/004,092	GROPP, ROBERT	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jyoti Nagpaul	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on an amendment filed on 10/04/2004.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8 and 9 is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1-5** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein in view of Cross.

Bernstein describes a system for performing a plurality of independent analysis procedures simultaneously, each procedure employing a tissue sample and at least one process step for operating on that sample, multiple process steps are done in parallel processes. The system comprises of a robotic device for moving a tissue sample to various processing stations (13). The robotic arm is capable of moving the sample from a first one of the reagent trays to a second one of the reagent trays (See col. 36, lines 60-67, Refer to Fig. 2). The system also includes a processor/computer (15), which selects the next tissue sample to move, when to move it, and where to move it.

Bernstein fails to describe an optimized automatic program sequence according to which identically operating processing stations are defined as backup stations and are correspondingly utilized if a required processing station is occupied. Bernstein also fails to describe the priority list for backup stations are definable by the user.

Cross discloses a sample handling system for processing electrical wire harnesses, which includes a wire segment transport system for selectively transporting

Art Unit: 1743

batches of wire segments to various processing stations in a simultaneously or sequential manner. The wire carrier (72) comprises a substantially rectangular open top container and a plurality of vertical divider (82), which are slidably received into the container. A system controller (102) oversees the operation of the system and transmits batches of computer process control data to the various processing stations. A batch may be sent to a station, if available. A duplicate or equivalent processing station is also available if said station has encountered failure or if occupied. The routing of said batches may be definable by the user (col. 4, lines 9-19, See Figure 3).

It would have been obvious to one of the ordinary skill in this art at the time of the invention by applicant to modify the system of Bernstein to include the features of Cross. Such a modification would have provided an optimized automatic program sequence according to which identically operating processing stations are defined as backup stations and are correspondingly utilized if a required processing station is occupied. The program would have taken into account a priority list of identically operating processing stations as backup stations and the priority list for backup stations. The backup stations are definable by the user because the system maximizes system efficiency and reliability. This modification would have been obvious to minimize the effect of failures in individual elements and also very advantageous in particular for treatment stations with very long processing times.

***Allowable Subject Matter***

**Claims 6 and 7** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art does not teach, or fairly suggest the calculation of the priority list is accomplished in consideration of shortest paths and shortest transport times.

**Claims 8 and 9** are allowed.

***Response to Arguments***

Applicant's arguments filed on June 3, 2004 have been fully considered but they are not persuasive. With respect to Claims 1-5, Cross discloses a batch of segments maybe rerouted to a duplicate or equivalent processing station in event of a failure at a station. This can be construed that the processing station when in use is occupied. With regards to priority list of backup stations, Cross defines a main processing station and a backup processing station for a single process thus defining a priority list, main and back up processing station.

In response to applicant's argument that Cross and Bernstein are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Cross discloses the processing of specimen batches and Bernstein discloses the process of samples. Thus the art is analogous.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jyoti Nagpaul whose telephone number is 571-272-1273. The examiner can normally be reached on Monday thru Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1743

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JN

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700